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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,033	08/30/2001	Tatsuaki Okamura	14892	9511
23389	7590	11/12/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			EDELMAN, BRADLEY E	
			ART UNIT	PAPER NUMBER
			2153	
DATE MAILED: 11/12/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/943,033

Applicant(s)

OKAMURA, TATSUAKI

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/30/01, 8/30/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a first Office action on the merits of this application. Claims 1-16 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanaka (U.S. Patent No. 6,351,763), in view of Masahide et al. (JP Patent No. 11-203215, as translated via JPO's website, hereinafter "Masahide").

In considering claim 1, Kawanaka discloses a method of transmitting and receiving an electronic mail comprising:

generating an encoded electronic mail to which an "open date" is added in a transmitting side communication terminal (col. 5, lines 16-20); and

decoding and opening said encoded electronic mail in a receiving side communication terminal after current date and hour reach said "open date" (col. 5, lines 42-44; col. 6, lines 26-30, 42-44, wherein the "sealed" message is the encoded message and the "seal" is opened (i.e. the message decoded) at the date that begins the designated "duration for opening" the message).

However, Kawanaka does not disclose using an “open date *and hour*.” Nonetheless, designating both a date and hour for opening an e-mail received at a receiving computer is well known, as evidenced by Masahide. In a similar art, Masahide discloses an e-mail system for receiving e-mail, wherein the sender designates both an opening date and opening hour for the message, and wherein the receiving computer opens the message when that date and hour is reached (see ¶ 4 & 6 of the English Translation). Given the teaching of Masahide that both e-mail opening dates and hours can be set by a message sender, a person having ordinary skill in the art would have readily recognized the desirability and advantages of including such a feature in the system taught by Kawanaka, so that a recipient of a message regarding a particular scheduled event is reminded of the event at a time very close to the scheduled event (see Masahide, ¶ 2 of the English translation). Thus, it would have been obvious to designate the opening time of Kawanaka according to both date and hour, as taught by Masahide.

Claim 15 recites a terminal apparatus for performing the same steps as claim 1, and is thus rejected for the same reasons.

2. Claims 2-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanaka, in view of Masahide, and further in view of what is well known in the art.

In considering claim 2, the combined teaching of Kawanaka and Masahide further discloses preventing said encoded electronic mail from being decoded in said receiving side communication terminal receiving said encoded electronic mail, until said current date and hour reach said "open date and hour" (Kawanaka, col. 6, lines 25-30).

However, neither Kawanaka nor Masahide disclose requiring said receiving side communication terminal to set said current date and hour when said receiving side communication terminal does not have said current date and hour. Nonetheless, Examiner takes Official notice that it is well known to require a desktop computer to set a current date and hour when the computer does not have the correct current date and hour (i.e. when an event such as daylight savings time occurs). Given this knowledge, it would have been obvious to a person having ordinary skill in the art to include the feature of automatically setting the current date and hour after a time change such as daylight savings time in the receiving computer of Kawanaka and Masahide, so that the recipient who uses the computer can be aware of the correct current time by viewing his or her computer screen. Therefore, it would have been obvious in the system taught by Kawanaka and Masahide to include the feature of requiring the receiving side terminal to set the current date and hour if it is not correctly set to the actual current time and date.

In considering claim 3, again, Examiner takes official notice that it is well known to change the time on a computer when the current date and hour changes, such as during daylight savings time. Claim 3 encompasses such a situation, wherein when the

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current date and hour is changed to another date and hour (i.e. when daylight savings time occurs), the "open date and hour" on the receiving computer will change due to resetting of the computer's clock in accordance with daylight savings time. Thus, the combined teaching of Kawanaka and Masahide, combined with the knowledge that the computer's time can be changed due to events such as daylight savings time and the like, discloses the claim features of claim 3.

In considering claim 4, for a change such as an hour shift for daylight savings time, the relation between the current date and hour and said "open date and hour" prior to the change will be equivalent to the relation between said other current date and hour and said "open date and hour" after the change (i.e. both current dates and hours will still be earlier than both open dates and hours). Note, the word "relation" as used in the claim is broad and does not require an hour-to-hour or other specific correlation.

In considering claim 5, the combined teaching of Kawanaka and Masahide further discloses requiring said receiving communication terminal to open said encoded electronic mail when said current date and hour reach said "open date and hour" (Masahide, ¶ 4 describes automatically opening the mail after the open date and hour is reached).

In considering claim 6, Kawanaka further discloses adding a mail deletion key code to said encoded electronic mail, recording said received encoded electronic mail

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together with the mail deletion code, and deleting the encoded electronic mail having the mail deletion code (col. 5, lines 41-44, 56-65).

Claims 7, 11, and 13 contain the same limitations as claim 5, and are thus rejected for the same reasons.

Claims 8, 12, and 14 contain the same limitations as claim 6, and are thus rejected for the same reasons.

Claims 9 and 10 contain the same limitations as claims 3 and 4 respectively, and are thus rejected for the same reasons.

Claim 16 includes the same limitations as combined claims 3 and 4, and is thus rejected for the same reasons.

3. Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanaka (JP Patent No. 11-168495, as translated via JPO's website, hereinafter "Kawanaka JP"), in view of Masahide.

In considering these claims, Kawanaka JP discloses the same invention as Kawanaka described above (i.e. the U.S. Patent). See, for instance, ¶¶56 - ¶¶66. Thus, claims 1 and 15 are rejected for the same reasons discussed above.

4. Claims 2-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawanaka JP, in view of Masahide, and further in view of what is well known in the art.

In considering these claims, Kawanaka JP discloses the same invention as Kawanaka described above (i.e. the U.S. Patent). See, for instance, ¶¶56 - ¶¶66. Thus, claims 2-14 and 16 are rejected for the same reasons discussed above.

Examiner Comment

Note that Applicant's *disclosure* does describe certain features that are not described in the prior art of record. However, these features are not currently claimed. For instance, if claims more clearly described the "date and hour" as the date and hour *set on the recipient's computer*, and then further elaborated on the correlation between the time changes made to the recipient's computer and the time changes made to the open date and hour of the electronic mail message (i.e. equivalent changes in the *relative* times, rather than equivalent changes in the "relation" as is currently claimed), such claim language would likely overcome the prior art currently of record. Applicant is encouraged to set up an interview with Examiner to discuss such matters, if Applicant so desires.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 703-306-3041. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Bradley Edelman".

BE
October 25, 2004